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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. | |
|---|----------------|----------------------|-------------------------|------------------|--|
| 10/671,768 | 09/29/2003 | Franz Danekas | Q76728 | 7542 | |
| 23373 | 590 05/09/2006 | | EXAMINER | | |
| SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 | | | EASHOO, MARK | | |
| | | | ART UNIT | PAPER NUMBER | |
| WASHINGTO | N, DC 20037 | | 1732 | | |
| | | | DATE MAILED: 05/09/2006 | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| Advisory Action | | | | | |
|-----------------|-----|---------------|-------|--------|-------|
| Before | the | Filing | of an | Appeal | Brief |

| | —-т. <u>.:</u> | |
|--------------------|----------------|--|
| Application No. | Applicant(s) | |
| 10/671,768 | DANEKAS ET AL. | |
| Examiner | Art Unit | |
| Mark Eashoo, Ph.D. | 1732 | |

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|--|---|---|--|
| The MAILING DATE of this communication appe | ars on the cover sheet with the o | correspondence add | ress |
| THE REPLY FILED <u>01 May 2006</u> FAILS TO PLACE THIS APP | LICATION IN CONDITION FOR AL | LOWANCE. | |
| 1. The reply was filed after a final rejection, but prior to or or this application, applicant must timely file one of the follow places the application in condition for allowance; (2) a Not a Request for Continued Examination (RCE) in compliant time periods: | wing replies: (1) an amendment, aft stice of Appeal (with appeal fee) in | fidavit, or other evider compliance with 37 C | nce, which FR 41.31; or (3) |
| a) The period for reply expires 4 months from the mailing date | of the final rejection. | | |
| b) The period for reply expires on: (1) the mailing date of this A no event, however, will the statutory period for reply expire Examiner Note: If box 1 is checked, check either box (a) or TWO MONTHS OF THE FINAL REJECTION. See MPEP 7 | ater than SIX MONTHS from the mailin (b). ONLY CHECK BOX (b) WHEN THE | g date of the final reject | on. |
| Extensions of time may be obtained under 37 CFR 1.136(a). The date | | 136(a) and the appropria | te extension fee |
| have been filed is the date for purposes of determining the period of exunder 37 CFR 1.17(a) is calculated from: (1) the expiration date of the set forth in (b) above, if checked. Any reply received by the Office late may reduce any earned patent term adjustment. See 37 CFR 1.704(b) NOTICE OF APPEAL | tension and the corresponding amount shortened statutory period for reply orig r than three months after the mailing da | of the fee. The approprinally set in the final Offi | iate extension fee ce action; or (2) as |
| The Notice of Appeal was filed on A brief in comp filing the Notice of Appeal (37 CFR 41.37(a)), or any external a Notice of Appeal has been filed, any reply must be filed AMENDMENTS | nsion thereof (37 CFR 41.37(e)), to | avoid dismissal of th | |
| 3. The proposed amendment(s) filed after a final rejection, | but prior to the date of filing a brief | will not be entered b | ecause |
| (a) ☐ They raise new issues that would require further co (b) ☐ They raise the issue of new matter (see NOTE below) | nsideration and/or search (see NO w); | TE below); | |
| (c) ☐ They are not deemed to place the application in be appeal; and/or | tter form for appeal by materially re | ducing or simplifying | the issues for |
| (d) They present additional claims without canceling a | corresponding number of finally rej | ected claims. | |
| NOTE: <u>See Continuation Sheet</u> . (See 37 CFR 1.1 | | | |
| 4. The amendments are not in compliance with 37 CFR 1.1 | | mpliant Amendment | (PTOL-324). |
| 5. Applicant's reply has overcome the following rejection(s) | | | |
| Newly proposed or amended claim(s) would be a non-allowable claim(s). | llowable if submitted in a separate, | timely filed amendme | ent canceling the |
| 7. For purposes of appeal, the proposed amendment(s): a) how the new or amended claims would be rejected is pro The status of the claim(s) is (or will be) as follows: | | ll be entered and an e | explanation of |
| Claim(s) allowed: <u>none</u> . Claim(s) objected to: <u>none</u> . | | | |
| Claim(s) rejected: <u>1-11</u> . | | | |
| Claim(s) withdrawn from consideration: <u>none.</u> AFFIDAVIT OR OTHER EVIDENCE | | | |
| The affidavit or other evidence filed after a final action, but because applicant failed to provide a showing of good an was not earlier presented. See 37 CFR 1.116(e). | nt before or on the date of filing a N d sufficient reasons why the affida | otice of Appeal will <u>no</u> vit or other evidence i | ot be entered s necessary and |
| 9. The affidavit or other evidence filed after the date of filing entered because the affidavit or other evidence failed to showing a good and sufficient reasons why it is necessar | overcome all rejections under appe | al and/or appellant fa | Is to provide a |
| 10. ☐ The affidavit or other evidence is entered. An explanation REQUEST FOR RECONSIDERATION/OTHER | n of the status of the claims after e | ntry is below or attacl | ned. |
| 11. ☐ The request for reconsideration has been considered but | it does NOT place the application i | n condition for allowa | nce because: |
| 12. Note the attached Information Disclosure Statement(s). 13. Other: | (PTO/SB/08 or PTO-1449) Paper N | Mark Eashoo, Ph.I Primary Examiner | |
| | | Δrt I Init: 1732 / | |

04 May 106

Continuation of 3. NOTE: Applicant's amendment to claim 1 raises new issues that requires substantial further consideration and/or search. Specifically, the previous amendment recited "introducing said particle mixture into said screw". Based upon the drawings (see Fig. 2), which clearly shows a hollow screw, this apparatus had a resonable expectation of performing this limitation. However, as set forth by the examiner, such limitation was unsupported by the specification and was rejected under 35 USC 112, 1st paragraph. No art rejection was made because no art was found to meet this limitation in the context of the claimed subject matter as a whole. It is noted that the Office cannot ignore the new matter and it must be considered as part of the claim when considering other possible rejections (see examiner note 3 in MPEP 706.03(o)). Thus, the amendment after final proposes a change that substantially changes the scope of the claim and would require further consideration and/or search.